

Serial No. 10/003,635

REMARKS

The Office action dated November 2, 2004 and the cited references have been carefully considered.

Status of the Claims

Claims 7-13 and 19-28 remain in the current prosecution. Claims 1-6 and 14-18 are withdrawn pursuant to an earlier election to prosecute claims 7-13 and 19-28 in the current prosecution.

Claims 7-13 and 19-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kunzler (U.S. Patent 5,710,302). Claims 7-11, 13, and 19-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Meijs (U.S. Patent 5,981,615). Claims 7-12 and 19-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lesko (U.S. Patent 5,897,811). The Applicants respectfully traverse all of these rejections for the reasons set forth below.

Remarks on the Amendments to the Claims and the Specification

The subscripts of the various groups $-Si(R_1)(R_1)O-$ of claim 7 is amended to clarify that they are independently chosen, as disclosed in the original specification and claims. The recitation of different subscripts x, y, and z in amended claim 7 is merely another way to express the original disclosure that "y may be the same or different." No new matter has been added.

Paragraphs [0008] and [0015] are amended to recite the correct conventional names for the indicated bivalent groups. No new matter has been added.

Claim Rejection Under 35 U.S.C. § 102

Claims 7-13 and 19-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kunzler. The applicants respectfully traverse this rejection because Kunzler does not disclose each and every element of each of claims 7-13 and 19-28.

Serial No. 10/003,635

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Every element of the claimed invention must be *literally* present, arranged as in the claim. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Kunzler discloses a monomer (represented by his Formula VI) wherein the activated unsaturated group is connected to the central Si atom by an alkylene group having 1-10 carbon atoms.

In contradistinction, amended claim 7 and all claims dependent therefrom recite a siloxysilane wherein the polymerizable group is linked to the central Si atom by a linking group X selected from the group consisting of C₁₋₁₀ alkyleneoxy, C₆₋₃₆ arylene and C₆₋₃₆ aryleneoxy. Thus, Kunzler does not disclose each and every element of each of claims 7-13 and 19-28.

Since Kunzler does not disclose each and every element of each of claims 7-13 and 19-28, Kunzler does not anticipate these claims.

Claims 7-11, 13, and 19-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Meijs. The Applicants respectfully traverse this rejection because Meijs does not disclose each and every element of each of claims 7-11, 13, and 19-28.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Every element of the claimed invention must be *literally* present, arranged as in the claim. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Serial No. 10/003,635

Meijis discloses a free-radical polymerizable group linked to a siloxane group by at least one linking group having at least one of -COO- and -CONH-. See column 2, lines 30-46.

In contradistinction, amended claim 7 and all claims dependent therefrom recite a siloxysilane wherein the polymerizable group is linked to the central Si atom by a linking group X selected from the group consisting of C₁₋₁₀ alkyleneoxy, C₆₋₃₆ arylene and C₆₋₃₆ aryleneoxy. Thus, Meijis does not disclose each and every element of each of claims 7-11, 13, and 19-28.

Since Meijis does not disclose each and every element of each of claims 7-11, 13, and 19-28, Meijis does not anticipate these claims.

Claims 7-12 and 19-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lesko. The Applicants respectfully traverse this rejection because Lesko does not disclose each and every element of each of claims 7-12 and 19-28.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Every element of the claimed invention must be *literally* present, arranged as in the claim. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Lesko discloses only allyl tris(trimethylsiloxy) silane. Column 4, line 31. In other words, each of Lesko's three single siloxy units is connected to three methyl groups.

In contradistinction, amended claim 7 and all claims dependent therefrom recite that at least one R₁ group connected to a single siloxy unit is not a C₁ alkyl ("when x, y, or z is 1, at least one R₁ group is not a C₁ alkyl"). Thus, Lesko does not disclose each and every element of each of claims 7-12 and 19-28.

Serial No. 10/003,635

Since Lesko does not disclose each and every element of each of claims 7-12 and 19-28, Lesko does not anticipate these claims.

The Examiner appears to opine that these claims are anticipated by Lesko because "Lesko's polymeric composition is substantially the same as Applicants' polymeric composition." The Applicants respectfully traverse this apparent reason for the rejection of the claims because in order to anticipate a claim, the reference must disclose identically the claimed invention. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) ("Every element of the claimed invention must be *literally* present, arranged as in the claim. . . . The *identical* invention must be shown in as complete detail as is contained in the . . . claim." (emphasis added)). A similar but not identical disclosure in the prior-art reference is not competent to anticipate a claim.

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of claims at an early date is solicited.

Respectfully submitted,



Toan P. Vo, Ph.D.
Attorney for the applicants
Registration No. 43,225
(585)338-8071

Rochester, New York
January 24, 2004